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10/073,110	02/12/2002	Edward McGugan	WH 10 921US	3703

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EXAMINER

PECHHOLD, ALEXANDRA K

ART UNIT	PAPER NUMBER
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3671

DATE MAILED: 05/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/073,110

Applicant(s)

MCGUGAN, EDWARD

Examiner

Alexandra K Pechhold

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 3/3/03, 3/12/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 1-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-13, 15 and 16 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments regarding Restriction Requirement***

1. Applicant has provisionally elected to prosecute claims 11-16 but elected with traverse and protested the examiner's restriction. Applicant argues that claims 1 and 11 are based on a single disclosed embodiment. Yet such argument does not overshadow the fact that claims 1 and 11 recite different features and elements, and claim 11 recites a subcombination, whereas claim 1 recites a combination which has a grader. Regardless of the classification, the combination recited in claim 1 positively recites a grader blade and upper and lower slide rails, which are not positively recited in claim 11, making the restriction proper. For these reasons, the examiner proceeds with the examination of claims 11-16 below.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 11-13, 15, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Atherton et al (US 4,037,670).**

Regarding claim 11, Atherton discloses a bearing holder seen as bracket (61) in Fig. 3, a removable bearing received in the holder seen as clamp shoe (63) in Fig. 3, and at least one adjustment mechanism seen as the hydraulic ram (67) in Fig. 3. The

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end of the hydraulic ram (67) is received in the bracket (61) as illustrated in Fig. 3, and acting on the rear face of the clamp shoe (63). The hydraulic ram (67) includes at least one short stroke hydraulic cylinder seen as cylinder (68). The hydraulic ram (67) has at least one fitting disclosed as valve (89) (Col 5, lines 12-35).

Regarding claim 12, Atherton illustrates a U-shaped channel in Fig. 3, since the bracket (61) is U-shaped.

Regarding claim 13, Atherton discloses that ordinarily a second clamp mechanism (not shown) is mounted to the outside of the left hand support arm (32) and of course both of the clamp mechanisms have their hydraulic rams (67) (Col 5, lines 58-66).

Regarding claim 15, the bracket (61) of Atherton must have a recess, since it has room to receive the piston rod (72) therethrough as shown in Fig. 3.

Regarding claim 16, the clamp shoe (63) and bracket (61) of Atherton cooperate to generally surround the piston rod (72) on the hydraulic ram (67) as depicted in Fig. 3, while exposing a rear surface of the piston rod (72) through a port in the bracket (61).

**4. Claims 11-13, 15, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Hart et al (US 3,983,945).**

Regarding claim 11, Hart discloses a bearing holder seen as clamp member (43) in Fig. 2, a removable bearing seen as U-shaped wear member (28) in Fig. 2, and at least one adjustment mechanism being received in the holder seen as hydraulic jack (41) and rod (44) in Fig. 2. The adjustment mechanism includes at least one short

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stroke hydraulic cylinder seen as hydraulic jack (41). A fitting is disclosed in column 2, lines 59-68 as the control valve (52).

Regarding claim 12, the clamp member (43) is seen as a U-shaped member in Fig. 2.

Regarding claim 13, other than hydraulic jack (41), Hart also discloses a double acting hydraulic jack (36) (Col 2, lines 42-49).

Regarding claims 15 and 16, Hart illustrates the end of the rod (44) engaging the clamp member (43) in Fig. 3, and the clamp member (43) and U-shaped wear member (28) cooperating to generally surround the hydraulic jack (41).

#### ***Allowable Subject Matter***

5. Claim 14 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***


6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexandra Pechhold whose telephone number is (703) 305-0870. The examiner can normally be reached on Mon-Thurs. from 8:00am to 5:30pm and alternating Fridays from 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will, can be reached on (703)308-3870. The fax phone number for this Group is (703) 305-3597.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.

  
**Thomas B. Will**  
**Supervisory Patent Examiner**  
**Group 3600**

AKP  
4/25/03